

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER L. SOWERBY

Appeal No. 94-4429
Application 07/910,967¹

ON BRIEF

Before WEIFFENBACH, PAK, and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow
claims 1, 2, 5-8 and 11-36 as amended after final rejection.
These are all of the claims remaining in the application.

¹ Application for patent filed July 9, 1992. According to applicant,
this application is a continuation-in-part of Application 07/640,173, filed
January 11, 1991.

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THE INVENTION

Appellant claims processes for forming combinations of trithianes and phosphorous acid and/or thiophosphorous acid derivatives which, appellant states (specification, page 37, line 33 - page 38, line 3), are useful as additives for lubricants and other functional fluids such as automatic transmission fluids and hydraulic fluids. Claim 1 is illustrative and is appended to this decision.

THE REFERENCES

Hook et al. (Hook)	2,531,129	Nov. 21, 1950
Bartlett	3,159,664	Dec. 1, 1964
Le Suer	3,197,405	Jul. 27, 1965
Braid	3,644,206	Feb. 22, 1972
Meinhardt	4,123,370	Oct. 31, 1978
Watson et al. (Watson)	4,328,111	May 4, 1982

THE REJECTIONS

Claims 1, 2, 5, 6 and 33-35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Braid or Hook. Claims 7, 8 and 11-36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Braid or Hook, each in view of Meinhardt, Watson, Bartlett or Le Suer.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the

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aforementioned rejections are not well founded. Accordingly, these rejections will be reversed.

Each of appellant's claims requires that the aldehyde have at least one alpha-hydrogen atom. That is, in the aldehyde, which is represented by R^1CHO , the R^1 group must have at least one hydrogen on the carbon atom adjacent to the $-CHO$. Braid states that the aldehyde used to make his composition has no alpha-hydrogen atoms (col. 1, lines 39-40; col. 2, lines 8-10). Hook uses only formaldehyde or "a formaldehyde yielding substance such as paraformaldehyde, trioxymethylene and the like" (col. 1, line 46 - col. 2, line 2).²

The examiner points out this difference and argues that appellant's claimed invention clearly would have been *prima facie* obvious to one of ordinary skill in the art based on the rationale in *In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985).

The examiner reached her conclusion of obviousness of appellant's claimed invention based on a *per se* rule that use of a new starting material in a prior art process would have been obvious to one of ordinary skill in the art. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d

² The remaining references are relied upon by the examiner only for motivation to use a neutralizing agent in the Braid and Hook processes (answer, page 4).

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1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease." The court further stated:

Mere citation of *Durden*, *Albertson*, or any other case as a basis for rejecting process claims that differ from the prior art by their use of different starting materials is improper, as it sidesteps the fact-intensive inquiry mandated by section 103. In other words, there are not "*Durden* obviousness rejections" or "*Albertson* obviousness rejections," but rather only section 103 obviousness rejections. 71 F.3d at 1570, 37 USPQ2d at 1132.

When an examiner is determining whether a claim should be rejected under 35 U.S.C. § 103, the claimed subject matter as a whole must be considered. See *Ochiai*, 71 F.3d at 1569, 37 USPQ2d at 1131. The subject matter as a whole of process claims includes the starting materials and product made. When the starting and/or product materials of the prior art differ from those of the claimed invention, the examiner has the burden of explaining why the prior art would have motivated one of ordinary skill in the art to modify the materials of the prior art process so as to arrive at the claimed invention. See *Ochiai*, 71 F.3d at 1570, 37 USPQ2d at 1131. In the present case, the examiner has not carried this burden.

The examiner further argues that appellant's specification includes some of the prior art aldehydes (answer, page 5). This

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argument is not well taken because the examiner has not established that it was known in the art that aldehydes having alpha-hydrogen atoms were suitable. The examiner has used

appellant's own teaching against him, which is improper. See *In re Zurko*, 111 F.3d 887, 889, 42 USPQ2d 1476, 1479 (Fed. Cir. 1997).

For the above reasons, we conclude that the examiner has not carried her burden of establishing a *prima facie* case of obviousness.

DECISION

The rejections under 35 U.S.C. § 103 of claims 1, 2, 5, 6 and 33-35 over Braid or Hook and of claims 7, 8 and 11-36 over Braid or Hook, each in view of Meinhardt, Watson, Bartlett or Le Suer, are reversed.³

REVERSED

³ We note that in claim 7, it appears that in the first structure "D", the "P" should be double bonded to "S" instead of "O", and that in the second structure "D", the "P" should be double bonded to "O" instead of "S". See the specification, page 6, line 16 - page 7, line 18.

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CAMERON WEIFFENBACH)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
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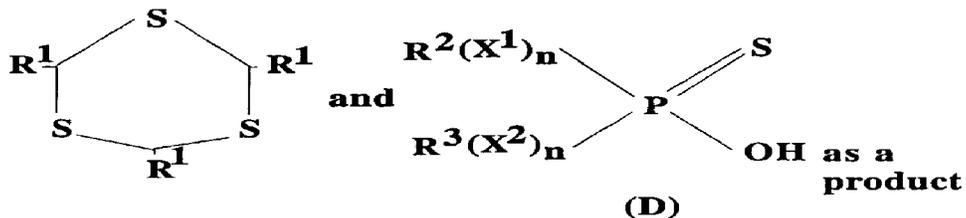
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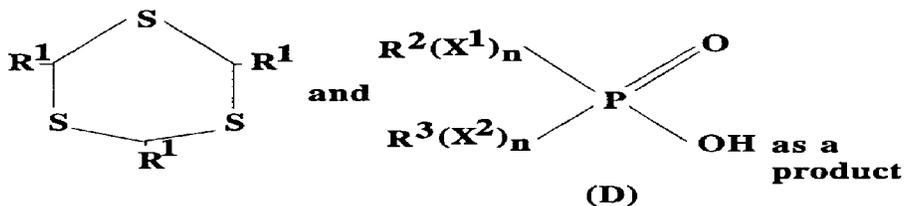
1. A process for the preparation of an extreme pressure additive comprising:
 reacting (A) R¹CHO, and



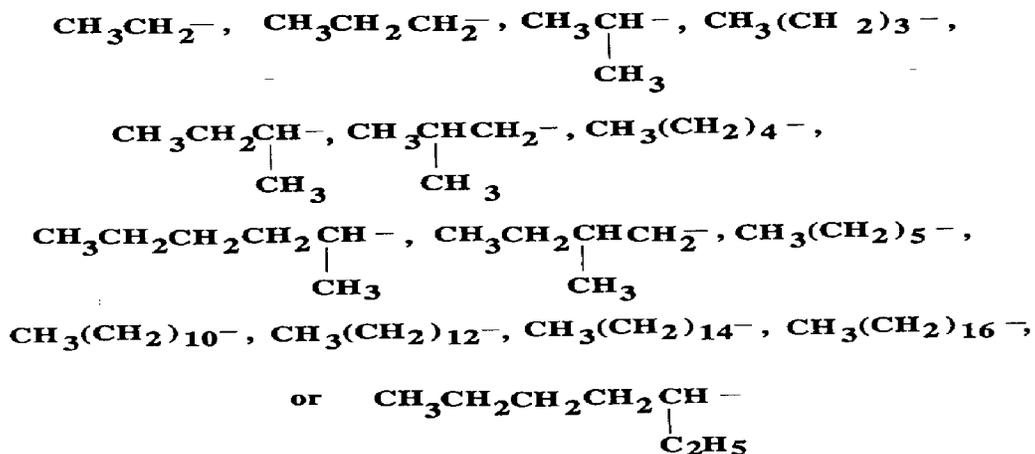
at an (A):(B) molar ratio of 1:1 and at a temperature of from ambient up to about 150°C forming



or at an (A):(B) molar ratio of 2:1 and at a temperature of from ambient up to about 150°C forming



wherein R¹ is



R² and R³ are each independently a hydrocarbonyl group containing from 1 to about 30 carbon atoms, X¹ and X² are each independently oxygen or sulfur and n is independently zero or one.

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